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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,672	05/11/2001	Hideomi Suzawa	12732-038001	5083

26171 7590 06/03/2003  
FISH & RICHARDSON P.C.  
1425 K STREET, N.W.  
11TH FLOOR  
WASHINGTON, DC 20005-3500

EXAMINER

SIMKOVIC, VIKTOR

ART UNIT PAPER NUMBER

2812

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/852,672

Applicant(s)

SUZAWA ET AL.

Examiner

Viktor Simkovic

Art Unit

2812

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28, 32-34, 38 and 39 is/are allowed.
- 6) ☒ Claim(s) 9-27, 29-31 and 35-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9 and 10-17, 29, 35 are rejected under the judicially created doctrine of double patenting over claim 8 of allowed U.S. Pub. 2002/0066705 (App. No. 09/852,282, which has not been assigned a patent number yet) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: While the present application does not claim using dry etching to form the electrodes, this only makes the present claim 9 broader in scope. And though claim 8 of Application No. 09/852,282 does not claim forming a high concentration impurity region in the sixth step and a low concentration impurity region in the eighth step, this is taught in paragraph 40 of Application No. 09/852,282. With

regard to dependent claims 10-17, 29, 35, these contain no allowable subject matter as these limitations are discussed in the specification of Application No. 09/852,282

Claims 18-19 and 20-27, 30-31, 36-37 are rejected under the judicially created doctrine of double patenting over claim 10 of allowed U.S. Pub. 2002/0016028 (App. No. 09/873,334, which has not been assigned a patent number yet) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claim 19 of the present application only omits one step, and forms both impurity regions with one step, whereas in claim 10 of Application No. 09/873,334 they are formed in two steps. However, though the third electrode is formed between the two impurity forming steps in claim 10 of Application No. 09/873,334, the width of the second conductive layer, which is used as the mask, does not change, and thus the switching of the order of the steps is irrelevant and has no patentable significance. With regard to dependent claims 20-27, 30-31, 36-37, these contain no allowable subject matter as these limitations are discussed in the specification of Application No. 09/873,334.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

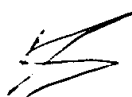
***Allowable Subject Matter***

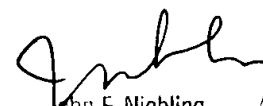
Claims 28 and 33 and the dependent claims 32, 34, 38-39 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Prior art of record fails to teach the method of forming a semiconductor device that includes the steps of laminating first and second conductive films on the substrate, followed by the formation of a conductive layer, which is used as a mask to form a high concentration impurity region, followed by an etching of the first conductive film to form an electrode.

***Conclusion***

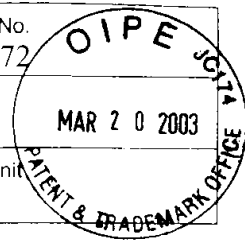
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viktor Simkovic whose telephone number is 703-308-6170. The examiner can normally be reached on Mon - Fri, 9:00 - 6:00, except every other Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Niebling can be reached on 703-308-3325. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

  
Viktor Simkovic  
May 22, 2003

  
John E. Niebling  
Supervisory Patent Examiner  
Technical Center 2800

#16

Substitute Form PTO-1449 (Modified)  <b>Information Disclosure Statement by Applicant</b> (Use several sheets if necessary)  (37 CFR \$1.98(b))	U.S. Department of Commerce Patent and Trademark Office		Attorney's Docket No. 12732-038001	Application No. 09/852,672
	Applicant Hideomi Suzawa et al.			
	Filing Date May 11, 2001		Group Art Unit 2812	



**U.S. Patent Documents**

Examiner Initial	Desig. ID	Document Number	Publication Date	Patentee	Class	Subclass	Filing Date If Appropriate
<i>[Handwritten]</i>	AA	5,112,766	05/12/1992	Fujii et al.			07/16/1991
<i>[Handwritten]</i>	AB	5,599,741	02/04/1997	Matsumoto et al.			06/07/1995
<i>[Handwritten]</i>	AC	5,605,854	02/25/1997	Yoo			02/20/1996
<i>[Handwritten]</i>	AD	5,851,885	12/22/1998	Wen			05/30/1997
<i>[Handwritten]</i>	AE	5,973,378	10/26/1999	Ohtani			11/24/1997
<i>[Handwritten]</i>	AF	6,001,714	12/14/1999	Nakajima et al.			09/26/1997
<i>[Handwritten]</i>	AG	6,225,966	05/01/2001	Ohtani et al.			03/23/1998
<i>[Handwritten]</i>	AH	6,271,065	08/07/2001	Miyamoto et al.			01/31/2000
<i>[Handwritten]</i>	AI	6,323,070	11/27/2001	Yamazaki			09/14/1998
<i>[Handwritten]</i>	AJ	6,335,290	01/01/2002	Ishida			03/29/1999
<i>[Handwritten]</i>	AK	6,365,917	04/02/2002	Yamazaki			11/16/1999
<i>[Handwritten]</i>	AL	US 2001/0041392 A1	11/15/2001	Suzawa et al.			05/11/2001
<i>[Handwritten]</i>	AM	US 2001/0052950 A1	12/20/2001	Yamazaki et al.			03/16/2001
<i>[Handwritten]</i>	AN	US 2002/0000551 A1	01/03/2002	Yamazaki et al.			03/02/2001
<i>[Handwritten]</i>	AO	US 2002/0016028 A1	02/07/2002	Yamazaki et al.			06/05/2001
<i>[Handwritten]</i>	AP	US 2001/0041392 A1	11/15/2001	Suzawa et al.			05/11/2001
<i>[Handwritten]</i>	AQ	US 2001/0049197 A1	12/06/2001	Yamazaki et al.			06/04/2001
<i>[Handwritten]</i>	AR	US 2002/0006705 A1	01/17/2002	Suzawa et al.			05/10/2001

**Foreign Patent Documents or Published Foreign Patent Applications**

Examiner Initial	Desig. ID	Document Number	Publication Date	Country or Patent Office	Class	Subclass	Translation	
							Yes	No
<i>[Handwritten]</i>	AS	WO 87/07079	11/19/1987	WIPO				

**Other Documents (include Author, Title, Date, and Place of Publication)**

Examiner Initial	Desig. ID	Document
<i>[Handwritten]</i>	AT	Hatano et al., "A Novel Self-aligned Gate-overlapped LDD Poly-Si TFT with High Reliability and Performance", IEDM Technical Digest 97, pp. 523-526

Examiner Signature <i>[Handwritten Signature]</i>	Date Considered <i>5/22/03</i>
EXAMINER: Initials citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	